

REMARKS

This document is filed in reply to the Final Office Action dated January 12, 2007 ("Final Office Action"). Applicants have filed herewith a Request for Continued Examination and amended claims 2, 3, and 29-31 to correct typographical errors. No new matter has been introduced.

Claims 1-51 are pending. Claims 6-28, 34, and 39-51 have been withdrawn from further consideration for covering a non-elected invention. Claims 1-5, 29-33, and 35-38 will be under examination. Reconsideration of this application is requested in view of the following remarks.

Claim objection and rejection

The Examiner objected to claim 29 for containing informality, and rejected claims 2-5, 30-33, and 35-38 for being indefinite. See the Final Office Action, page 3, the penultimate paragraph; and page 4, lines 3-11, respectively. In view of the above amendments, Applicants respectfully request that the objection and rejection be withdrawn.

Election/Restriction

The Examiner maintained the sequence restriction raised in the office action mailed March 13, 2006 ("Restriction Requirement"). In response to the Restriction Requirement, Applicants elected SEQ ID NOs: 9 and 13 with traverse, presented arguments, and requested that five related sequences (i.e., SEQ ID NOs: 9 and 13-16) be examined concurrently. However, the Final Office Action countered that "[t]he [sequence restriction] requirement is still deemed proper." See the Final Office Action, page 2, last line.

Applicants respectfully traverse. According to the Restriction Requirement, the sequence restriction was raised basing on MPEP 803.04. See, pages 3-4, carryover paragraph. Applicants note that the scope of MPEP 803.04 is limited to cases where the claimed inventions are "Nucleotide Sequences," as evidenced by the title of MPEP 803.04. Indeed, this section provides the following:

Polynucleotide molecules defined by their nucleic acid sequence (hereinafter "nucleotide sequences") that encode different proteins are structurally distinct chemical compounds. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121.

Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.* (underline added)

It is clear that claims subject to restriction requirement under this section are those where "nucleotide sequence is ... an ... invention." Further, MPEP 803.04 provides three exemplary claims, which fall in the scope of restriction requirement under this section:

(A) an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000;

(B) a combination of DNA fragments comprising SEQ ID Nos. 1-1,000; and

(C) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000.

Without exception, all of the three claims are drawn to nucleotide sequences, and, accordingly, subject to restriction requirement under this section.

In contrast, claims 1-5, 29-33, and 35-38, the claims at issues here, are not drawn to nucleotide sequences at all. In fact, they cover a method for preparing an array for authenticating whether a plant sample is originated from a known plant or a method for using the array for determining whether a plant sample is originated from a known plant. Although the methods involve processing nucleotide sequences, this processing does not covert the method claims into nucleic acid claims. The claims are simply not nucleic acid claims and the claimed invention is not nucleotide sequences as required in MPEP 803.04. Thus, Applicants respectfully submit that the Examiner reliance on MPEP 803.04 to raise the sequence restriction is untenable.

Even for claims covering nucleotide sequences, MPEP 803.04 does not necessarily require the sequence restriction as asserted by the Examiner. In contrast, it permits a reasonable number of nucleotide sequences to be considered without restriction for a policy reason that:

to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Director has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. (emphasis added)

The methods of claims 1-5, 29-33, and 35-38 are well within the scope of this policy to "aid the biotechnology industry." Also, Applicants requested only five related sequences (SEQ ID NOs: 9 and 13-16), rather than all of the sequences recited in the claims, be considered without restriction. In view of the method nature of the claims, Applicants submit that "five" is a reasonable number.

Applicants are researchers at a university and do not enjoy financial resources as big corporations do. Restricting the method claims in the manner as the Examiner asserted would severely burden Applicants since, to achieve a meaningful protection, Applicants would have to file a large number of divisional applications.

The restriction as the Examiner asserted would also lead to an unjust result when Applicants could not afford to pursue all of the divisional applications merely because of their lack of financial resources. That is, others could get around any allowed claims by using nucleic acids that Applicants have disclosed in the application, but could not afford to elect. This inequitable treatment would disproportionately put university researchers, such as Applicants here, at disadvantage and favor big corporations, thereby frustrating the purpose of the policy set forth in MPEP 803.04. It also follows that this inequitable treatment would discourage university researchers and others, who lack sufficient financial resources, from making and patenting inventions in this field.

In view of the above remarks, Applicants respectfully request that the sequence restriction be withdrawn and SEQ ID NOs: 9 and 13-16 be considered concurrently.

CONCLUSION

Applicants submit that grounds for the objection, rejection, and restriction asserted by the Examiner have been overcome. On this basis, early favorable action is solicited.

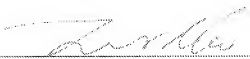
Applicant : Hot Shan Kwan et al.
Serial No. : 10/797,668
Filed : March 10, 2004
Page : 14 of 14

Attorney's Docket No.: 17329-002001 / 04F050US

Enclosed is a Request for Continued Examination. The fees in the amount of \$395 are being paid concurrently on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other required fees to deposit account 06 1050, referencing the attorney docket number shown above.

Respectfully submitted,

Date: 4-12-2007


Jianming Hao, Ph.D.
Reg. No. 54,694

PTO Customer No. 26161
Fish & Richardson P.C.
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21609983.doc